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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,471	09/14/2005	Joelle Bedat	13156-00022-US	8311
23416 7590 10/07/2008 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
FAISON GEL, VERONICA FAYE				
ART UNIT		PAPER NUMBER		
1793				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,471

Applicant(s)

BEDAT ET AL.

Examiner

VERONICA FAISON GEE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4, 13, 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by de Jong (US Patent 4,929,475).

De Jong teach a stoving lacquers which are essentially useful in "coil coating" and provide a finish simulating that of a metallic lacquer comprise a storable colored film-forming binder composition having colorless transparent particles dispersed therein (abstract). The reference further teaches that the film-forming binder may be based on polyurethanes, polyesters or polyacrylates which can be cured by heating (col. 2 lines 33-38). The binder composition may include a plasticizer to ensure adequate flexibility of the stoved layer and/or a flow additive to facilitate formation of a coating of even thickness (col. 2 lines 54-58). The composition may also include pigments (col. 3 lines 3-6). Example III discloses that the plasticizer is ethylhexylphthalate (Palatinol AH),

which Applicant has disclosed as a cyclohexanepolycarboxylic acid derivative in the specification. The composition as taught by de Jong appears to anticipate the claimed invention.

Claims 1-3, 5-7, 12, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Bruchmann et al (US 2005/0147834).

Bruchmann et al teach a multilayer material for producing packaging comprising at least 2 films and a layer printed with a printing ink; wherein the printing ink comprising a hyperbranched polyester containing functional groups (abstract). The ink composition comprises at least one solvent or a mixture of different solvents, at least one colorant, at least one polymeric binder and at least one of the polymeric binders comprising hyperbranched polyester containing functional groups (0020). The synthesis of the hyperbranched polyesters may preferably take place as depicted below, without the invention being thereby restricted to the use of the polyesters synthesized by this preparation method. In the case of the preferred synthesis the reaction solutions reacted comprise (a) one or more dicarboxylic acids or one or more derivatives thereof with one or more alcohols having a functionality of at least three, (b) or one or more tricarboxylic acids or higher polycarboxylic acids or one or more derivatives thereof with one or more diols, (c) or one or more tricarboxylic acids or higher polycarboxylic acids or one or more derivatives thereof with one or alcohols having a functionality of at least three, (d) or one or more dihydroxy or polyhydroxycarboxylic acids, (e) or one or more

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hydroxydicarboxylic or hydroxypolycarboxylic acids, or mixtures of at least two of the above reaction solutions. The dicarboxylic acids which can be reacted in reaction solutions according to variant (a) include, for example, azelaic acid, succinic acid, glutaric acid, adipic acid, pimelic acid, sebacic acid, dodecane- α,ω -dicarboxylic acid, phthalic acid, isophthalic acid or terephthalic acid, it also being possible for the dicarboxylic acids to be substituted. It is additionally possible to use mixtures of two or more of the aforementioned representatives. The dicarboxylic acids can be used either as such or in the form of derivatives. Derivatives are preferably monoesters or diesters, in which case the radicals R of the one or two COOR groups may independently of one another comprise, preferably, groups having 1-60 carbon atoms. The groups R may also contain heteroatoms or further substituents. By way of example, R comprises C₁₋₈ alkyl radicals, such as methyl, ethyl, propyl, isopropyl, n-butyl, i-butyl, t-butyl, hexyl radicals, for example, or C₆₋₁₂ aryl or arylalkyl radicals such as benzyl radicals, for example. Preference extends to radicals which contain oxygen atoms in the chain and have the formula $-(CHR'-CHR''O)_nH$, n customarily being a natural number from 1-20 and R' and R" independently of one another being alternatively H or a methyl or ethyl group. Particular preference is given to using azelaic acid, succinic acid, glutaric acid, adipic acid, phthalic acid, isophthalic acid, terephthalic acid or the monomethyl or dimethyl esters thereof. Very particular preference is given to using adipic acid. As alcohols with a functionality of at least three it is possible, for example, to use the following: glycerol, butane-1,2,4-triol, n-pentane-1,2,5-triol, n-pentane-1,3,5-triol, n-hexane-1,2,6-triol, n-

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hexane-1,2,5-triol, n-hexane-1,3,6-triol, trimethylolbutane, trimethylolpropane or ditrimethylolpropane, trimethylolethane, pentaerythritol or dipentaerythritol; sugar alcohols such as, for example, mesoerythritol, threitol, sorbitol, mannitol or mixtures of the above alcohols having a functionality of at least three. Preference is given to using glycerol, trimethylolpropane, trimethylolethane or pentaerythritol. Examples of tricarboxylic or polycarboxylic acids which can be used in reaction solutions according to variant (b) include 1,2,4-benzenetricarboxylic acid, 1,3,5-benzenetricarboxylic acid, 1,2,4,5-benzenetetracarboxylic acid, and mellitic acid. The tricarboxylic or polycarboxylic acids may be used either as such or else in the form of derivatives, in which case the derivatives are preferably monoesters or polyesters as defined above. As diols for reaction solutions according to variant (b) of the present invention use is made, for example, of ethylene glycol, propane-1,2-diol, propane-1,3-diol, butane-1,2-diol, butane-1,3-diol, butane-1,4-diol, pentane-1,4-diol, pentane-1,5-diol, pentane-2,3-diol, pentane-2,4-diol, hexane-1,2-diol, hexane-1,6-diol, hexane-2,5-diol, heptane-1,2-diol, 1,7-heptanediol, 1,8-octanediol, 1,2-octanediol, 1,9-nonanediol, 1,10-decanediol, 1,2-decanediol, 1,12-dodecanediol, 1,2-dodecanediol, diethylene glycol, triethylene glycol, dipropylene glycol, tripropylene glycol, polyethylene glycols $\text{HO}(\text{CH}_2\text{CH}_2\text{O})_n\text{H}$ or polypropylene glycols $\text{HO}(\text{CH}(\text{CH}_3)\text{CH}_2\text{O})_n\text{H}$ or mixtures of two or more representatives of the above compounds, n being an integer and $n \geq 4$. Preference is given to ethylene glycol, propane-1,2-diol, and also diethylene glycol, triethylene glycol, dipropylene glycol and tripropylene glycol. Reaction solutions which can be reacted according to variant

(c) contain, for example, one or more triols and one or more tetracarboxylic acids or one or more derivatives thereof. According to variant (c) it is also possible to react one or more tricarboxylic acids or one or more derivatives thereof with one or more tetrafunctional alcohol. The reaction of a triol with a tricarboxylic acid or derivatives is preferably successful when the hydroxyl groups or the carboxyl groups differ greatly from one another in reactivity. The molar ratio of hydroxyl groups to carboxyl groups in the case of variants (a) to (c) is from 3:1 to 0.3:1, preferably from 2:1 to 0.5:1, in particular from 1.5:1 to 0.75:1. Reaction solutions which can be reacted according to variant (d) contain one or more dihydroxy- or polyhydroxycarboxylic acids which contain at least 2 hydroxyl groups per molecule, examples being dimethylolpropionic acid, dimethylolbutyric acid, tartaric acid, 3,4-dihydroxyhydrocinnamic acid, 2,3-dihydroxybenzoic acid, 2,4-dihydroxybenzoic acid, 2,5-dihydroxybenzoic acid, 3,4-dihydroxybenzoic acid and 2,6-dihydroxybenzoic acid or mixtures thereof. Reaction solutions which can be reacted according to variant (e) contain one or more hydroxydicarboxylic or hydroxypolycarboxylic acids, examples being tartaric acid, citric acid, mallic acid, 4-hydroxyphthalic acid, 2-hydroxyterephthalic acid or mixtures thereof. The dihydroxy- or polyhydroxycarboxylic acids and hydroxydicarboxylic or hydroxypolycarboxylic acids from variants (d) and (e) can be used either as such or else in the form of derivatives, the derivatives preferably being esters as defined above. It is also possible to react mixtures of at least two of the above reaction solutions of variants (a) to (e) (0050-0070). The ink composition may further comprise additives and

auxiliaries present in the amount up to 10 percent by weight (0084). The composition appears to anticipate the claimed invention.

Response to Arguments

Applicant's arguments filed 7-8-08 have been fully considered but they are not persuasive.

Applicant argues the reference do not disclose cyclohexane polycarboxylic acid derivative.

Applicant admits that ethylhexylphthalate (Platinol AH), disclosed as cyclohexane polycarboxylic acid derivative in the specification. Applicant argues that ethylhexylphthalate is not what the applicant is claiming in claim 4. The Examiner would like to point out that the claim 4 states additives is a cyclohexane polycarboxylic acid **derivative**. Applicant has not given any evidence to the contrary, particularly when the specific tradename that is give in the specification is the same that is in the reference.

Applicant also admits that Bruchmann various dicarboxylic acid and polycarboxylic acids and **derivatives**. The reference appears to disclose all of the components need to contribute to the produce of cyclohexane polycarboxylic acid derivatives, and therefore it would encompass the claimed polycarboxylic acid derivatives as claimed by Applicant.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **VERONICA FAISON GEE** whose telephone number is **(571)272-1366**. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

/V. F. G./
Examiner, Art Unit 1793